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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,625	12/11/2003	Valerie M. Bennett	RSW920030295US1	2663

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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2443

NOTIFICATION DATE	DELIVERY MODE
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07/13/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

Office Action Summary	Application No. 10/733,625	Applicant(s) BENNETT ET AL.	
	Examiner DAVID E. ENGLAND	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 14 – 16, 18, 20 – 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 14 – 16, 18, 20 – 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 14 – 16, 18, 20 – 24 are presented for examination.

Claim Objections

2. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of a timer can be interpreted as a calendar that has the ability to schedule an event, i.e., from the present to the time the event occurs is a type of timer since it can be interpreted as a count down till the event, hence a timer.

Specification

3. The amendment filed 04/24/2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The Applicant as amended the specification on paragraph 0013 to state, "... such that at least one condition is placed on at least one portion of the identified content (where the portion ~~may comprise~~ comprises a subset of the identified content ~~in its entirety~~)..." This changes the previously accepted interpretation of the claimed invention where the portion may be defined as the content "in its entirety". As amended now, the portion is now defined as being a subset only and goes to exclude the previously defined understanding of the Applicant's term, i.e., before the "at least one portion" could be defined as a

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portion of content or all the content and now narrows the definition as only being a portion in the specification. Applicant may claim this type of limitation as only being a portion, if they wish, but may not change the specification in a manner that introduces new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 14, 15, 16, 18, 22 – 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Claim(s) 1, 14, 15, 16, 18, 22 – 24 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The claimed method includes steps of “identifying, consulting, offering, storing and subsequently evaluating,” that, in view of the broadest reasonable interpretation of the claim(s) as required by MPEP 2111, the claim(s) could be completely performed mentally, verbally and/or without a machine OR fail to transform any underlying subject matter to any different state or thing. The amended claims fail to claim hardware that would perform any of the steps. Previously claimed graphical user interface that constructed a markup language document was interpreted as hardware performing some functions of the claimed invention. Such language is not canceled out and nothing of any

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hardware was replaced in place if it. The claims as stated now could be interpreted as human acts performed with paper and pencil. For example, nothing in the claims define what the "source" could be, i.e., a person with a print-out of a web page. Furthermore, storing could be a person placing printed out documents in a cabinet and evaluating the documents when asked to do so or when they are scheduled to. Applicant is asked to amend the claims to claim hardware, that is non-transitory, to perform the method steps above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 14 – 16, 18, 20 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorvari et al., (2004/0043758 hereinafter Sorvari) in view of Currans et al. (6731393 hereinafter Currans).

9. Referencing claims 1, 20 and 21, as closely interpreted by the Examiner, Sorvari teaches enabling users to subscribe to content in a computing environment, comprising:

10. identifying a content access behavior pattern of a user, (e.g., ¶ 0054, 0055, 0059 & 0167-0168);

11. responsive to the identifying, consulting a mapping that associates content access behavior patterns of users with corresponding candidate content subscriptions to be offered to

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users exhibiting the associated content access behavior patterns, thereby determining a selected one of the candidate content subscriptions which corresponds to the identified content access behavior pattern of the user, and selected on indicating a subset of content generated by a content source, (e.g., ¶ 0061 – 0067, 0073-0078, 0194 – 0197 et seq.);

12. generating a markup language document representing the determined candidate content subscription, (e.g., ¶ 0166 – 0173 & Figures 10 – 11H);

13. offering, to the user, a subscription to the subset of the content by rendering a subscription interface for the subset, the subscription interface comprising a Web page which is distinct from a Web page usable for rendering the content generated by the content source, (e.g., ¶ 0166 – 0173, 0179-0181, 0194 – 0197 et seq. & Figures 9A – 11H);

14. responsive to acceptance of the offered subscription by the user, storing a trigger document associated with the user and the content, the trigger document specifying at least one condition associated with the subset, (e.g., ¶ 0166 – 0173, 0179-0181 & Figures 9A – 11H); and

15. subsequently evaluating a then-current version of the content generated by the content source, using the at least one condition specified in the trigger document, to determine whether a then-current version of the subset of the then-current version of the content is considered a match to the at least one condition, and if so, automatically sending the then-current version of the subset to the user as the subscription, (e.g., ¶ 0011, 0062, 0086-0088, 0123 and 0194 – 0197 et seq.).

16. Sorvari teaches the use of calendar information, (e.g., ¶ 0308), but does not specifically subsequently evaluating a then-current version of the content generated by the content source, using the at least one condition specified in the trigger document, to determine whether a then-

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current version of the subset of the then-current version of the content is considered a match to the at least one condition, and if so, automatically sending the then-current version of the subset to the user as the subscription and scheduling time on a electronic calendar of the user.

17. Currans teaches subsequently evaluating a then-current version of the content generated by the content source, using the at least one condition specified in the trigger document, to determine whether a then-current version of the subset of the then-current version of the content is considered a match to the at least one condition, and if so, automatically sending the then-current version of the subset to the user as the subscription and scheduling time on a electronic calendar of the user, (e.g., col. 12, line 58 – col. 13, line 52 & Figures 6 - 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Currans with Sorvari because utilizing a user calendar to have information sent to the user enables the user to dictate when they would receive information and not have information sent every time a match is made from the trigger. This would also lessen the amount of network traffic in the system.

18. As per claim 15, as closely interpreted by the Examiner, Sorvari teaches the subsequently evaluating is invoked responsive to occurrence of an event, (e.g., ¶ 0194 – 0197 et seq.).

19. As per claim 16, as closely interpreted by the Examiner, Sorvari teaches the identifying is performed by an inference engine, (e.g., ¶ 0091).

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20. As per claim 18, as closely interpreted by the Examiner, Sorvari teaches the identifying comprises identifying how the user interacts with a rendering of the content which is generated by the content source, (e.g., ¶ 0190).

21. As closely interpreted by the Examiner, claim 14 is rejected for similar reasons as claim 1 since it can be interpreted that the calendar could be considered a timer of sorts and therefore the motivation also applies.

22. As per claim 22, as closely interpreted by the Examiner, Sorvari and Currans teach each of the at least one condition specified in the trigger document comprises a data name and a data value, (e.g., Sorvari ¶ 0059, 0123 et seq., 0180—0183, filtering and changing settings on an interface that is an XML file, or “document” that is stored at a server., Currans col. 9, lines 27 et seq., col. 13, lines 10 et seq., Figures 2 - 6).

23. As per claim 23, as closely interpreted by the Examiner, Sorvari and Currans teach each of the at least one condition specified in the trigger document further comprises a comparison operator, (e.g., Sorvari ¶ 0059, 0123 et seq., 0180—0183, filtering and changing settings on an interface that is an XML file, or “document” that is stored at a server., Currans col. 9, lines 27 et seq., col. 13, lines 10 et seq., Figures 2 - 6).

24. As per claim 24, as closely interpreted by the Examiner, Sorvari and Currans teach the trigger document further specifies at least one process to be invoked subsequently evaluating

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determines that the then-current version of the subset is considered a match to the at least one condition, (e.g., Sorvari ¶ 0059, 0123 et seq., 0180—0183, filtering and changing settings on an interface that is an XML file, or “document” that is stored at a server., Currans col. 9, lines 27 et seq., col. 13, lines 10 et seq., Figures 2 - 6).

Response to Arguments

25. Applicant's arguments with respect to claims 1, 14 – 16, 18, 20 – 24 have been considered but are moot in view of the new ground(s) of rejection to the amended claim limitations.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. ENGLAND whose telephone number is (571)272-3912. The examiner can normally be reached on Mon-Thur, 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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